

**Remarks**

**The Invention**

The invention is directed to a device for minimizing cigarette sidestream smoke and reducing the free-burn rate of a burning cigarette. The device comprises a non-combustible tubular element encasing an effective length of a tobacco charge of a cigarette in the tubular element. The tubular element comprises ceramic material. As set forth in claim 10, the tubular element has means for both minimizing sidestream smoke emission from a burning tobacco charge and reducing free-burn rate of the burning tobacco charge to increase the number of puffs therefrom. As set forth in claim 11, the tubular element has a porosity for both minimizing sidestream smoke emission from a burning tobacco charge and reducing free-burn rate of the burning tobacco charge to increase the number of puffs therefrom.

**The Office Action**

Both claims stand rejected under 35 U.S.C. § 102(b) as anticipated by, or in the alternative under 35 U.S.C. § 103(a) as obvious over, Valdez, United States Patent Number 4,685,477. Valdez discloses a holder having three chambers, the first filled with a filter material, and the second and third aligned and separated to transfer ash from the second to the third chamber. Element 25 of Valdez is deemed to be the non-combustible tubular member of the claims, with perforation 26 providing the claimed porosity. The size and number of air intake spaces is said to control the rate at which the ember burns, enabling increase of the number of puffs. The tubular member that encloses a cigarette is said to minimize sidestream smoke. The Office Action also asserts that, because the structural elements are met in Valdez, it “would be obvious” to have met the claimed functions.

Both claims also stand rejected under the judicially-created doctrine of obviousness-type double patenting over claims 9 and 11 of United States Patent Number 6,371,127.

The Office Action did not acknowledge the claim of priority.

**The Cited Document**

Valdez, United States Patent Number 4,685,477, is directed to a device that assists a smoker in holding a cigarette or cigar during smoking. The device comprises a tubular smoke absorbent filter. A concentric second tubular member with a perforated wall may be provided. The tubular member may have an open distal end (for the ember end of the cigarette) and an open proximal end having a smoke absorbent material therein. Random smoke is purified. The device also can encompass an ash chamber to catch ashes that fall from the ember end of the cigarette or cigar.

The tubular member comprises a non-flammable and non-heat transferring material so that the ember does not damage the device. Ceramics, plastics, glass, porcelain and metal alloys are suitable material from which the tubular member can be fashioned. A concentric tube is placed in the tubular member to form an inner sleeve for retaining the filter material. This center tube is perforated. Ashes may gather in the center chamber formed thereby.

Valdez discloses a holder that has three chambers: a first chamber defined by the space between a perforated tubular member, concentrically situated around a perforated inner tubular member, and the inner tubular member, wherein the first chamber is substantially filled with a filter material; the second and third chambers are within the inner tubular member substantially coaxially aligned and separated by a wall having an aperture to transfer ash from the second chamber and the third chamber. According, to Valdez, air enters through perforated proximal end plate 22. Element 25 is deemed to be the non-combustible element, which as noted in Column 3, line 10, may be made of porcelain, a known ceramic, which is non-combustible and element 25 as shown in Figure 3 encases the tobacco charge which is deemed as the tobacco rod 14. The perforations 26 are said to provide for the claimed porosity.

**35 U.S.C. § 102 and 103**

The Examiner has rejected Claims 10 and 11 under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103 as obvious over Valdez. Applicants respectfully traverse these rejections. Not only does Valdez not disclose the claimed device, but also Valdez does not suggest the claimed invention.

The Office Action asserts that Valdez discloses a cigar or cigarette holder that has three chambers: the first chamber defined by the space between a perforated tubular member, concentrically situated around a perforated inner tubular member, and the inner tubular member, wherein the first chamber is substantially filled with a filter material; the second and third chambers are within the inner tubular member substantially coaxially aligned and separated by a wall having an aperture to transfer ash from the second chamber and the third chamber. The Office Action further asserts that the claimed non-combustible tubular member is deemed as element 25, and that the perforations 26 provide for the claimed porosity.

In accordance with that assertion, the plurality of air intake spaces, perforations 26, is said to enable the ember end of the cigar or cigarette to burn. As the smoker puffs or draws on the primary smoke filter end of the cigar or cigarette, air may be drawn into the second and third chambers through the air intake spaces (perforations 26) to enable the ember to burn; in this manner, sufficient air is provided for burning of the tobacco to generate smoke. The Office Action further asserts that it is possible to vary the size and/or number of the air intake spaces (perforations 26) to control the rate at which the ember end of the cigar or cigarette burns. In this manner, the cigar or cigarette may be made to burn slower and therefore, last longer than if smoked without the Valdez device. Perforations 26 of Valdez are said to reduce the free-burning

rate of the burning tobacco in order to increase the number of puffs from the burning tobacco charge as instantly claimed by applicant.

Applicants respectfully traverse this rejection. Perforations 26 do not serve to throttle the amount of air drawn into the core of the tubes. Rather, Applicants respectfully submit that elements 26 are “air outlet means” which serve as the *exhaust* pores through which air filtered of random smoke (e.g. sidestream smoke) escapes or is released (*see* Column 5, lines 7-15). It is actually perforated end plate 22 that Valdez teaches is the air intake element, as noted in Column 3, lines 55-57, that is useful for enabling the ember end of the cigar or cigarette to burn. Air may be drawn into the second and third chambers through the air intake spaces, element 22, to enable the ember to burn (*see* Column 4, lines 8-21). Valdez teaches that it is the design of end plate 22, not the air outlet means of element 26, that can be manipulated by changing the size and/or number of perforations to control the rate at which the ember end of the cigar or cigarette burns. Moreover, it is the same air intake spaces in end plate 22, not the perforations 26, which reduce the free-burning rate of the burning tobacco in order to increase the number of puffs from the burning tobacco charge.

Further, contrary to the assertions in the Office Action, the filter material in the first chamber formed by the concentric tubes of Valdez that minimizes the sidestream smoke (*see* Column 4, lines 38-68); the perforations 26 simply act as exhaust pores (*see* Column 5, lines 7-15).

Accordingly, Valdez teaches that element 22 acts as air intake spaces to control the rate at which the ember end of the cigar or cigarette burns and that the filter material in the first chamber 17 minimizes the sidestream smoke. In contrast, the claimed invention utilizes “a means” in claim 10, and specifically porosity in Claim 11, for both minimizing sidestream smoke and reducing the free-burn rate. Valdez requires two separate elements to achieve each of these effects.

For at least these reasons, Applicants respectfully traverse these rejections. Applicants respectfully submit that Claims 10 and 11 are allowable over Valdez and the prior art.

Applicants have filed herewith a terminal disclaimer with respect to U.S. Patent No. 6,371,127, thus making the obviousness-type double patenting rejection moot.

Applicants request that the Office acknowledge the claim of priority and all submissions required to perfect that claim.

Respectfully submitted,

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